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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,459	12/22/2004	Mika Watanabe	MARU.001	5043
21254 7590 11/23/2007 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			EXAMINER PETERSON, KENNETH E	
			ART UNIT 3724	PAPER NUMBER
			MAIL DATE 11/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/518,459

Applicant(s)

WATANABE, MIKA

Examiner

Kenneth E. Peterson

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-18 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 7-11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Newly submitted claims 9,10,11 and 13 are directed to inventions that are independent or distinct from the invention originally elected for the following reasons:

Claim 9 is drawn to the special technical feature of a plurality of concave portions for indicating blade position.

Claim 10 is drawn to the special technical feature of a centering mark.

Claim 11 depends from non-elected claim 8.

Claim 13 is drawn to the special technical feature of an up-curved guide plate.

In the election dated 03 May 07, Applicant elected to prosecute the special technical feature of the punch spacing being smaller than the punch diameters. There is two way-distinctness between the elected group and the above claims. There is also a significant search burden to search these disparate inventions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-11 and 13 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Particular attention is drawn to MPEP appendix AI, Annex B, c(ii).

While claims 12 and 14-18 were also drawn to different special technical features, Examiner concluded it would not be overly burdensome to search and examine these claims.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Groswith, III et al. (5,163,350), who shows a punching mechanism with all of the recited limitations including;

An operation part (37),

A punch blade group (26,31),

A rotational axis (best seen in figures 4 and 5) at a front end (left of figure 1),

A top base (27),

A bottom base (25) fixed to the top base at several locations, including a rear end (right of figure 1),

A slot (having workpiece 5 therein, figure 8).

A lifting mechanism (50) for lifting the punches.

As seen in figure 5, the punches are close enough together to effectively destroy information on the workpiece.

With regards to claims 2, it is required that each punch blade (31) have a diameter. While Groswith's blades are not circular, Examiner notes that the term "diameter" can be employed with any shape to indicate a line passing thru the center of that shape (see Webster's II dictionary). Accordingly, each of the rectangular cross-section punch blades (31) has a diameter.

Groswith does not explicitly state the diameter of his punch blades (31), but does say that the device is 40cm (400mm) long (line 25, column 5). Looking at figure 5, this

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means that each blade has a diameter of roughly 10mm, clearly with the recited range.

Also seen in figure 5 is the fact that the gap between the blades is smaller than the diameter of the blades.

4. Claims 1,12 and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Groswith, III et al. (5,163,350), who shows a punching mechanism with all of the recited limitations including;

- An operation part (37),

- A punch blade group (49),

- A rotational axis (best seen in figures 4 and 5) at a front end (left of figure 1),

- A top base (27,52),

- A bottom base (25) fixed to the top base at several locations, including a rear end (right of figure 1),

- A slot (having workpiece 6 therein, figure 8).

- A lifting mechanism (50) for lifting the punches.

As seen in figure 7, the punches are close enough together to effectively destroy information on the workpiece. A long string of numbers that have 3 of there numbers punched out is considered to be destroyed. Alternately, multiple punchings could be made to punch out all of the numbers.

In regards to claim 12, the top base (27,52) has a bottom plate (bottom of 52) that forms the slot.

In regards to claims 14, the top base (27,52) has fixing parts (section of the top of 52, alternately, section of the bottom part of 52) that receive the lifting mechanism (50).

In regards to claim 15, the lifting mechanism (50) is a coil spring.

In regards to claim 16, Groswith shows a raised part (46).

In regards to claim 17, the punches (49) are cylindrical.

In regards to claim 18, the punches (49) have the same diameter, as seen in figure 7.

5. Applicant's arguments have been fully considered but they are not all persuasive.

Applicant's new oath has been accepted.

Applicant has overcome the rejection under 35 USC 112.

Applicant argues against the prior art rejection, stating that Groswith has no lifting mechanism. However, Groswith *does* have a lifting mechanism (50). It appears that more structure needs to be added *to the independent claim* to distinguish over the prior art.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within


TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth E. Peterson whose telephone number is 571-272-4512. The examiner can normally be reached on Mon-Thur, 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

kp



KENNETH E. PETERSON
PRIMARY EXAMINER